

Applic. No. 09/817,963  
Amdt. dated September 12, 2006  
Reply to Office action of July 12, 2006

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 4-8 remain in the application.

In item 3 on page 2 of the above-identified Office action, claims 4-8 have been rejected as being obvious over Calabrese et al. (U.S. Patent 5,468,597) (hereinafter "Calabrese") in combination with Greenwood et al. (U.S. Patent 5,679,498) (hereinafter "Greenwood") or vice versa, further in combination with Bickford et al. (U.S. Patent 5,800,858) (hereinafter "Bickford") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 4 calls for, *inter alia*:

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applying to the first insulating layer a second insulating layer made of a photosensitive material.

In the response to amendment section on page 4 of the Office action, the Examiner stated that "applicant argued that the photoresist layer in Calabrese et al. (5,468,597) is not an insulating layer and that the photosensitive layer in Greenwood et al. (5,679,498) is not the same as a photoresist layer."

Furthermore, the Examiner stated that "the Examiner agrees in part. First off, claims 4, 7, and 8 do not require the first and second insulating layer be of the same material.

Secondly, the rejection is based upon a combination rejection wherein Bickford et al. (5,800,858) teaches a similar process whereby the first and second polymer layer can be of the same material. There is no requirement that the motivation to make the combination be expressly articulated in one or more of the references; the teaching suggestion or inference can be found not only in the references but also from knowledge generally available to one of ordinary skill in the art" (emphasis added).

Applicants never asserted or argued that the first and second insulating layer have to be of the same material. In the

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response dated April 26, 2006, applicants showed that neither Calabrese nor Greenwood disclose the claimed feature of a second insulating layer applied to the first insulating layer.

Contrary to the Examiner's allegation, applicants do not find any disclosure in Bickford of a "first and second polymer layer". The Examiner has not indicated where Bickford discloses a "first and second polymer layer". Therefore, it is believed that Bickford does not disclose a "first and second polymer layer". Bickford discloses methods for treating halogenated polymeric material to render it suitable for subsequent plating. Bickford does not have a need for a product/process, which requires two insulating layers.

Applicants acknowledge that one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. However, the other side of this argument is that one cannot argue obviousness where the rejections are based on a combination of references without *something* in the cited references (or in the knowledge generally available to one of ordinary skill in the art) suggesting such a combination of references. None of the applied references show or suggest a two-layer process/product as recited in claim 4.

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It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest applying to the first insulating layer a second insulating layer made of a photosensitive material, as recited in claim 4 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Moreover, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

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Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS

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Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the Examiner's comments, it is respectfully believed that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the Examiner is requested to withdraw the rejection.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 4. Claim 4 is,

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therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 4, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 4-8 are solicited.

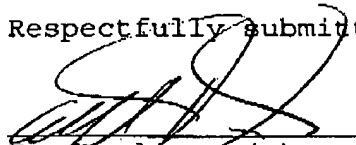
In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner  
Greenberg Sterner LLP, No. 12-1099.

Respectfully submitted,

  
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For Applicant(s)

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September 12, 2006

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